

UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	REQUEST DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
10/621,046	8/11/04	CONSTANTINE GRIGOROPOULOS, ET AL.	UCB-6 (B01-108)

Title: A METHOD FOR REPRODUCING A STRUCTURE
USING NANOPARTICLES

Art Unit	Paper Number
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Correspondence Address:

PETER L. MICHAELSON
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RED BANK, NEW JERSEY 07701

Licensee under 35 U.S.C. 184 is hereby granted to file in any foreign country a patent application and any amendments thereto corresponding to the subject matter of this U.S. application identified above and/or any material accompanying the petition. This license is conditioned upon modification of any applicable secrecy order and is subject to revocation without notice.

License Number: 535,265
Grant Date: 23-Sep-05

This license is granted retroactively to the date(s) and the country(s) indicated on the attached decision.

Approved:

for Commissioner of Patents and Trademark

This license empowers the filing, the causation and the authorization of the filing of a foreign application or applications on the subject matter identified above, subsequent forwarding of all duplicate and formal papers and the prosecution of such application or applications.

This license does not empower the filing of any applications, amendments, supplements or continuances originating in this country which disclose inventions, modifications, or variations not disclosed in the subject matter identified above.

This license is to be retained by the licensee and may be used at anytime on or after the date thereof. This license is not retroactive unless specifically indicated.

The grant of this license does not in any way lessen the responsibility of the licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations, especially with respect to certain countries, of other agencies, particularly the Office of Foreign Assets Control, Department of the Treasury; Office of Munitions Control, Department of State (with respect to Arms, Munitions and Implements of War); the Bureau of Trade Regulation, Office of Export Administration, Department of Commerce; and the Department of Energy.

LICENSE FOR FOREIGN FILING

[Title 35, United States Code (1952) Sections 184, 185, 186]



UNITED STATES PATENT AND TRADEMARK OFFICE

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In re: GRIGOROPOULOS, et al. :DECISION ON REQUEST
Petition No.: 10/621,046 :UNDER 37 CFR 5.25
Petition date: 11 August 2004

Title: A METHOD FOR REPRODUCING A STRUCTURE USING NANOPARTICLES

This is a decision on the petition for retroactive foreign filing license.

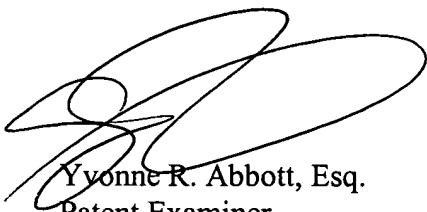
It has been determined that a retroactive license for foreign filing under 35 U.S.C. 184 be granted with respect to the filing(s) listed below. The petition complies with 37 C.F.R. 5.25 in that there is an adequate showing that the subject matter in question was not under secrecy order, that the license was diligently sought, and that the material was filed abroad without the required license under 37 C.F.R 5.11 through error and without deceptive intent.

Foreign Filing Location

EPO

Date

09 January 2001



Yvonne R. Abbott, Esq.
Patent Examiner
Licensing & Review
(571) 272-6896



IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

PATENT APPLICATION

Applicants: Constantine P. GRIGOROPOULOS, Nicole R. BIERI,
Dimos POULIKAKOS, Jaewon CHUNG

Atty. Doc. No.: UCB-6(B01-108)

Serial No.: 10/621,046

Filed: July 16, 2003

Group Art Unit: 2813

Confirmation No.: 8907

Examiner: Chandra P. Chaudhari

Title: A METHOD FOR PRODUCING A STRUCTURE USING
NANOPARTICLES

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Sept. 02, 2005

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S I R:

7/27/2005 AKELLEY 00000016 10621046 SUPPLEMENTAL PETITION PURSUANT TO
1 FC:1463 35 U.S.C § 184 FOR
200.00 RETROACTIVE FOREIGN FILING LICENSE

Petition

Applicants respectfully petition pursuant
to 35 U.S.C. § 184 that the foreign filing license granted
for the above application on November 25, 2003 be given
retroactive effect to January 9, 2001.

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OFFICE OF PETITIONS

Supplemental Petition

On August 11, 2004 Applicants petitioned pursuant
to 35 U.S.C. § 184 for the retroactive granting of a
foreign filing license for the above US patent application.

Appl. No. 10/621,046
Supplemental Petition
Reply to Decision on Request of March 22, 2005

This petition was denied March 22, 2005 on the grounds that the requirements of 35 C.F.R. § 5.25(a)(3)(i, ii, iii) have not been met. A copy of the Decision on Request is attached.

The present Supplemental Petition includes the attached:

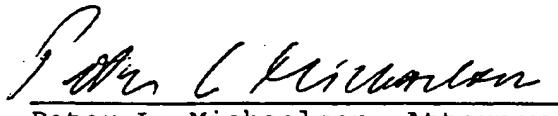
- a) Declaration from Constantine P. Grigoropoulos, the lead inventor, and
- b) Declaration from George Wolken, Jr., the lead attorney prosecuting the above-identified US patent application.

These declarations aver that: i) No secrecy order was or is in effect; ii) A foreign filing license was diligently sought following discovery of reasonable grounds for seeking one; and iii) An explanation of why the material was filed abroad without foreign filing license and without deceptive intent.

In light of the above, the attached Declarations, and the Petition and materials filed on August 11, 2004, applicants respectfully request that the foreign filing license granted on November 25, 2003 be given retroactive effect to January 9, 2001.

Respectfully submitted,

July 20, 2005


Peter L. Michaelson
Peter L. Michaelson, Attorney
Customer No. 007265
Reg. No. 30,090
(732) 530-6671

Appl. No. 10/621,046
Supplemental Petition
Reply to Decision on Request of March 22, 2005

MICHAELSON & ASSOCIATES
Counselors at Law
Parkway 109 Office Center
328 Newman Springs Road
P.O. Box 8489
Red Bank, New Jersey 07701

CERTIFICATE OF MAILING under 37 C.F.R. 1.8(a)

I hereby certify that this correspondence is being deposited on July 21, 2005 with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to Mail Stop Petitions, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Peter L Michaelson
Signature

30,090
Reg. No.

(UCB6SUPPLPETITION/ca:19)

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
10/621,046	11-Aug-04	CONSTANTINE GRIGOROPOULOS, ET AL.	UCB-6 (B01-108)

Title: A METHOD FOR REPRODUCING A STRUTURE
USING NANOPARTICLES

Art Unit	Paper Number
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RED BANK, NEW JERSEY 07701

PATENT & TRADEMARK OFFICE
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MAR 22 2005

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Please find attached a communication from the Examiner regarding the
Petition for Retroactive License under 37 CFR 5.25.



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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In re: GRIGOROPOULOS, et al. :DECISION ON REQUEST
Petition Filing Date: August 11, 2004 :UNDER 37 CFR 5.25
Serial No.: 10/621,046
Docket No.: UCB-6 (B01-108)

Title: A METHOD FOR PRODUCING A STRUCTURE USING NANOPARTICLES

This is a decision on the petition filed August 11, 2004 for retroactive foreign filing license.

Decision: Denied

37 CFR 5.25(a) requires the following:

1. A listing of each of the foreign countries in which the unlicensed patent application material was filed,
2. The dates on which the material was filed in each country,
3. A verified statement (oath or declaration) containing:
 - i. An averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order,
 - ii. A showing that the license has been diligently sought after discovery of the proscribed foreign filing, and
 - iii. An explanation of why the material was filed abroad through error and without deceptive intent without the required license under § 5.11 first having been obtained, and
4. The required fee (§ 1.17(h)).

The petition is Denied at this time in that the petition is defective since the requirements set forth in 37 C.F.R. 5.25(a)(3)(i, ii, iii) have not been met.

Although the Petition of Mr. Michaelson states the facts, background and basis for the Petition, there is no verified statement or declaration as to the nature of the error, or how and when it was discovered (thereby supporting a showing of diligence). The Petition merely states that a review of the facts indicates the possibility of an error occurred to invoke legal proceedings. In affect, it is not clear

from the Petition that the invention was made in the U.S. (i.e. that a foreign filing license is required) consequently invoking 35 U.S.C. 184 and 185. Petitioners must file a declaration(s) containing the pertinent information. Such a statement should include averments by those persons responsible for or having personal knowledge of the acts regarding filing in a foreign country (which may or may not be Mr. Michaelson, depending on his involvement in the foreign filing) and should be accompanied by copies of any necessary supporting documents such as letters of transmittal or instructions for filing. The acts which are alleged to constitute error without deceptive intent should cover the period leading up to and including each of the proscribed foreign filings.

Thus, in the absence of a verified statement including an explanation or showing that the license was diligently sought, and that the foreign application was filed through error without deceptive intent, the provisions of 37 CFR 5.25 have not been met.

Accordingly, the provisions of 37 CFR 5.25 not having been fully met, the petition is DENIED, and in the absence of any response within 60 days of the mailing date of this letter, such denial will be made final and the final action under 35 U.S.C. 185 will be taken. Extensions of time may be had under 37 C.F.R. 1.136(a).



Yvonne R. Abbott
Patent Examiner
Licensing & Review
(703) 308-2866



JRW SAC
J.

IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

PATENT APPLICATION

Applicants: **Constantine P. GRIGOROPOULOS, Nicole R. BIERI,
Dimos POULIKAKOS, Jaewon CHUNG**

Atty. Doc. No.: **UCB-6(B01-108)**

Serial No.: **10/621,046**

Filed: **July 16, 2003**

Group Art Unit: **2813**

Confirmation No.: **8907**

Examiner:

Title: **A METHOD FOR PRODUCING A STRUCTURE USING
NANOPARTICLES**

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

S I R:

**Petition Pursuant to 35 U.S.C § 184 for
Retroactive Foreign Filing License**

Petition

Applicants respectfully petition pursuant to 35 U.S.C. § 184 that the foreign filing license granted for the above application on November 25, 2003 be given retroactive effect to January 9, 2001.

Basis for Granting Petition

35 U.S.C § 184 provides for the retroactive granting of a foreign filing license "where an application has been filed abroad through error and without deceptive

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intent and the application does not disclose an invention within the scope of section 181 of this title."

The facts and circumstances surrounding the filing of a European patent application on January 10, 2001 are described below, clearly demonstrating that the European filing without a foreign filing license was without deceptive intent. If the European filing lies outside the scope of 37 C.F.R. § 5.11 (e)(1), then the European filing without a foreign filing license was in error.

The subject matter of the European patent application clearly lies outside the scope of 35 U.S.C § 181 as shown by an analysis of the subject matter of the application and by the granting of a foreign filing license on November 23, 2003 including within its scope that subject matter.

Factual Background

During a sabbatical leave, Professor Constantine Grigoropoulos of the University of California, Berkeley, CA performed cooperative research with scientists at the ETH (Eidgenössische Technische Hochschule) of Zurich, Switzerland while he was in residence at ETH. This research resulted in a European Patent Application No. 01 100 537.8 filed January 10, 2001. A copy as filed in English is attached as Attachment A. A copy of the published application EP 1 223 615 A1 is also attached as Attachment B. Believing the invention was not made in the

United States, no foreign filing license was sought pursuant to 37 C.F.R. § 5.11(e)(1).

The above-referenced US patent application ("'046") was filed on July 16, 2003 for which a foreign filing license was granted on November 25, 2003, Attachment C. The '046 application includes subject matter from the European filing.

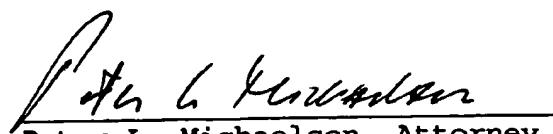
More thorough review of the facts and circumstances surrounding the invention tends to indicate the possibility that some features of the invention's conception may have occurred in the United States so as to invoke Sealectro Corp. vs. L.V.C. Industries (271 F. Supp. 835 (EDNY, 1967)). Applicants do not concede that Sealectro correctly states the applicable law, nor that the facts of the present invention and patent filings lie outside the provisions of 37 C.F.R. § 5.11(e)(1). However, applicants believe they fully comply with 35 U.S.C. § 184 and, therefore, hereby petition for retroactive effect to January 9, 2001 of the foreign filing license granted November 23, 2003.

Kindly charge the entire cost of \$ 130.00, as appropriate, of this petition to my deposit account

number 13-3083. To facilitate that charge, a duplicate copy of this petition is enclosed herewith.

Respectfully submitted,

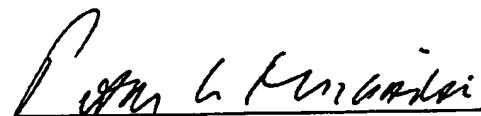
July 29, 2004


Peter L. Michaelson, Attorney
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CERTIFICATE OF MAILING under 37 C.F.R. 1.8(a)

I hereby certify that this correspondence is being deposited on July 30, 2004 with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to Mail Stop Petitions, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



Signature _____ Reg. No. _____
30,090

(u6pet/kab:ca/13)